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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,845	06/13/2000	Mark Rosenberg	5547	5201

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EXAMINER	
SUBRAMANIAN, NARAYANSWAMY	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/592,845	ROSENBERG, MARK	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6,43,44,46-48 and 85-90* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-6,43,44,46-48 and 85-90* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication from the Applicants dated July 14, 2004. Amendments to claim 1, 6, 43, 44 and 46-48, cancellation of claims 3 and 45 and addition of new claims 85-90 have been entered. Rejection of claims 43-48 made under 35 U.S.C. 112, second paragraph in the last office action have been withdrawn in view of the amendments. Claims 1, 2, 4-6, 43, 44, 46-48 and 85-90 are currently pending in the application and have been examined. The objections, rejections and response to arguments are stated below.

Specification

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1, 43 and 86 include the limitation "determining whether an investment period has ended". However, the specification does not provide an enabling disclosure to support the claimed limitation of "determining whether an investment period has ended". Lines 10-17 on

page 10 of the specification specify that the investment structure determines when to end the investment period. However the specification does not specify the step of "determining whether an investment period has ended".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:
> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 4-6, 43, 44, 46-48 and 85-90 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 2, 4-6, 43, 44, 46-48 and 85-90 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 101

6. The claimed invention is directed to non-statutory subject matter. Claims 1, 2, 4-6 and 86-90 are drawn to a method and computer readable medium providing instructions for an investment structure that are not tied to any technological art. Claims 1, 2, 4-6 and 86-90 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The computer readable medium is not positively cited as being on physical medium. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The

Board of Patent Appeals and Interferences has stated that claims lacking any technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 2, 4-6, 43, 44, 46-48 and 85-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelman (US Patent 6,064,986) in view of Hagan (US Patent 6,061,661) and further in view of Fabozzi et al (Reference U)

With reference to claims 1, 2, 6, 43, 44, 48, 85, 86, 87 and 90, Edelman teaches a computerized method, a computer memory (See Edelman Column 29 lines 1-5) and a computer readable medium providing instructions (See Edelman Column 10 lines 44-50) for providing an investment structure, the method comprising: receiving funds to be invested (See Edelman Claim 1c); providing a fixed component, the fixed component investing a first portion of funds and generating principal plus fixed interest (See Edelman Column 17 lines 56-59 and Column 17 line 66 – Column 18 line 3); providing a contingent component, the continent component investing a second portion of the funds and generating contingent interest (See Edelman Column 26 lines

38-43); wherein at least a portion of the fixed interest is re-invested in the fixed component (See Edelman Column 21 lines 61-64) and at least a portion of the contingent interest is re-invested in the contingent component (See Edelman Column 21 lines 61-64); determining whether an investment period has ended (See Edelman Claim 1m); and distributing all of the fixed component, the contingent component, the fixed interest, and the contingent interest when the investment period has ended (See Edelman Claim 1m). Contingent component is interpreted to include equity investments like S&P 500 Index because their returns are not fixed and their performance is contingent on the performance of individual securities that make up the index. Edelman also teaches the steps of including using a trustee for investing the fixed component (See Edelman claim 1f) and distributing the initial investment and accrued interest after an investment period (See Edelman claim 1m, Column 21 lines 53-55). The condition "at least one of when the predetermined period of time has expired and when the predetermined event has occurred" is interpreted to include the condition "when the investment period has ended" including a seven-year period. Transmitting the resources in accordance with the predetermined criteria to the beneficiary is interpreted to include distributing all of the fixed component, the contingent component, the fixed interest, and the contingent interest. The memory in claims 43, 44, 46-48 is interpreted be strictly computer memory only.

Edelman does not explicitly teach the steps of using a partnership for investing the contingent component, the fixed component invests sixty to ninety percent of the funds in the fixed component and the contingent component invests ten to forty percent of the funds in the contingent component.

Hagan teaches the step of using a limited partnership for investing. Limited partnerships are a type of partnership that limits the liability of the limited partners. Using this form of investment structure enables the pass through of income while limiting the liability of the limited partners.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Hagan to the disclosure of Edelman. The combination of the disclosures taken as a whole suggests that the investors would have benefited from the advantages offered to at least a part of their investments by the partnership structure.

Edelman and Hagan combined do not explicitly teach the steps wherein the fixed component invests sixty to ninety percent of the funds in the fixed component and wherein the contingent component invests ten to forty percent of the funds in the contingent component.

Fabozzi teaches the steps wherein the fixed component invests sixty to ninety percent of the funds in the fixed component (See Fabozzi page 947 Treasury and agency securities) and wherein the contingent component invests ten to forty percent of the funds in the contingent component. The percentile range covered by Fabozzi includes the range claimed in the invention. Since the investment includes only the Fixed and Contingent components, the percentage invested in the contingent component will be a complement of the percentage invested in the fixed component. Hence if ninety percent is invested in the fixed component then ten percent will be invested in the contingent component. Similarly if sixty percent is invested in the fixed component then by default forty percent will be invested in the contingent component.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the combined disclosures of Hagan and Edelman. The

combination of the disclosures taken as a whole suggests that the investors would have benefited from the diversification of risk provided by investing the proportions in the fixed and contingent components.

With reference to claims 4, 5, 46, 47, 88 and 89, Fabozzi teaches the steps wherein the investing the first portion step includes investing the fixed component in one or more of the following: treasury notes, AAA-rated securities, AA-rated securities, municipal bond notes, or variable rate notes (See Fabozzi pages 5-6, 419 and 420); and wherein the investing contingent component includes one or more of the following: futures, options, or forward positions (See Fabozzi Page 669)

Response to Arguments

8. Applicant's arguments with respect to claims 1-6 and 43-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

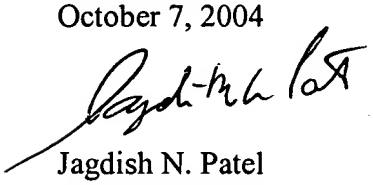
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
October 7, 2004



Jagdish N. Patel
Primary Examiner